

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket Number 17426US01

In re Application of:)	
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MacInnis)	
)	Electronically Filed
Serial No.: 09/437,580)	2/10/09
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Filing Date: 11/9/1999)	
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Examiner: Nguyen)	
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Confirmation No.: 8182)	
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Pre-Appeal Brief

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This correspondence is filed in response to the Office Action mailed 9/10/2008.

REMARKS

Claims 51-62 and 71-74 are presently pending and stand rejected as obvious under 35 U.S.C. § 103(a) from the combination of Akiyama in view of Marshall. Appellant respectfully requests pre-appeal brief review of the rejections.

Claim 51 recites, among other limitations, “blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory”. Examiner has indicated that:

Akiyama fails to teach ‘blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory.’ ... Marshall obviously teaches, ‘blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing how many pixels in memory.’

Office Action, 3/6/08 (OA) at 4.

Appellant traversed the rejection “because Examiner has not indicated *any* reason that one skilled in the art would combine Akiyama and Marshall as proposed by Examiner.” Response to Office Action, 6/6/08, at 2 (Emphasis Added).

Examiner responded that “The applicant argues that there is no specific suggestion of teaching *in the references* to combine prior art. In response, KSR forecloses the arguments that a specific teaching, suggestion, or motivation is required to support a finding obviousness.” Final Office Action, 9/10/08 at 13.

As can be seen from the emphasized portions of Appellant’s Response and the Final Office Action, Examiner has misstated Appellant’s argument. Although *KSR International Co. v. Teleflex Inc.*, ___ U.S. ___ (2007), foreclosed the argument that “a patent claim is only proved obvious if ‘some motivation or suggestion to combine the prior art teachings’ *can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art*”, KSR also held that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”

The final rejection and the non-final rejection only allege that each of the elements are found in Akiyama or Marshall.

According to MPEP 2143:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

EXEMPLARY RATIONALES

Exemplary rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Appellant respectfully traverses the rejection because Examiner has not provided any clear articulation of the reason(s) why the claimed invention would be obvious. Although Examiner has alleged that each of the elements of claim 51 are found in the prior art, *KSR* explicitly states that the foregoing is insufficient to establish obviousness.

Additionally, Akiyama teaches away from the claimed "blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory". Assignee respectfully submits that while col. 4, lines 6-7 recites, "For example, partition windows 76 and 77 are mapped into the exact same space in screen buffer 70", it is noted that Akiyama also states "the partition windows associated with the partitions in the scroll group will all shift right in presentation space buffer 50 whenever the cursor is within given spaces of the right edge of a partition window." Thus, Akiyama teaches preserving. MPEP 2143.01.II, states:

Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another.

Appellant raised this argument in the response to the office action. Response to Office Action, 6/6/08 at 2. The Final Rejection does not even acknowledge this, much less “weigh the suggestive power of each reference”. Appellant respectfully submits that weighing the suggestive powers of Akiyama and Marshall, the combination of Marshall in view if Akiyama teaches away from “blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory”.

Finally, Assignee submits that Marshall, Col. 3, Lines 35-45 do NOT teach “blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory”. Assignee respectfully submits that the foregoing does not even teach “blanking out how many pixels” much less “while continuing storing said how many pixels that are blanked in memory”. Appellant traversed the rejection on these grounds, and Examiner has simply repeated Examiner’s remarks regarding Marshall, reciting Col. 3, Lines 35-45, and making the conclusory statement that based on findings of facts, Marshall obviously teaches the claimed limitation.

It is noted that Examiner has stated:

When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate.

When the reference discloses all the limitations of a claim except a property or function and the examiner cannot determine whether or not the reference inherently possesses the properties which anticipated or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

The examiner is assuming that term ‘blanking out’ is functional language and until application specifies the uniqueness of ‘blanking out’, the examiner will continue to assume ‘blanking out’ is functional language and will not consider it for the basis for examiner claims 51, 55, 59, and 74.

Final Office Action at 14-15.

As best as Appellant can ascertain, it appears as though Examiner's position is that the burden of proof of establishing that Marshall does not inherently teach "blanking out how many pixels are indicated by the numerical value of the plurality of graphics data, while continuing storing said how many pixels that are blanked in memory" is shifted to Appellant under the holding in *In re Fitzgerald*.

Assignee respectfully traverses the foregoing. It is noted that the first quoted two paragraphs can be found in MPEP 706.02(m). It is noted that the foregoing are listed as "examples of circumstances where this paragraph ['Claim [1] rejected under 35 U.S.C. 102 ([2]) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over [3]'] may used". MPEP 706.02(m), Paragraph 7.27. However, the "basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980)" occurs "Once a Reference Teaching Product Appearing to be Substantially Identical is the Basis of a Rejection, and the Examiner Presents Evidence or Reasoning to show Inherency, the Burden Shifts to the Application to show an Unobvious Difference." MPEP 2112.V. Examiner has not established that the Marshall reference teaches a product appearing to be *substantially identical*. Accordingly, the holding of *In re Fitzgerald* is not applicable to the present case.

CONCLUSION

For at least the foregoing reasons, Assignee respectfully submits that each of the pending claims are allowable and Examiner is respectfully requested to pass this case to issuance. The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: February 10, 2009

Respectfully submitted,



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